

R E M A R K S

In the Specification, amendments have been made in response to the Examiner's objection to Figure 1. Element 23 in Figure 1 is now identified in the Specification as electrical conductors.

Claim 1 and 5 have been amended to further define the invention and thereby expedite prosecution of the present Application. In particular, Claims 1 and 5 have been amended to define the magnetically transparent electrostatic shield as being intimately interposed between the induction coil and one side of the lamp body. Support for this amending is found throughout the Application, in particular, page 5, lines 1-3 and FIG. 1. Claims 3 and 4 have been canceled.

Claims 3 and 4 stand rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 6,056,848, which issued to Daviet. In view of the cancellation of Claims 3 and 4, Applicant submits that the rejection is deemed overcome.

Claims 1, 2 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,619,103, which issued to Tobin in view of Daviet. This rejection is respectfully traversed and reconsideration thereof is requested.

The present invention relates to an inductively-coupled, electrodeless fluorescent lamp which includes a lamp body having two opposed sides; an induction coil on one side of lamp body; and a magnetically transparent electrostatic shield intimately interposed between the induction coil and one side of lamp body. The shield comprises an insulating substrate, an electrically conductive layer on the substrate including means for reducing capacitive coupling between a voltage on the induction coil and a plasma discharge within the lamp body. The electrically conductive layer has a thickness between 400 Å and 1000 Å, inclusive. The benefits of having the electrostatic shield in such close proximity to the induction coil and lamp body of an electrodeless fluorescent lamp are discussed in the first full paragraph on page 5 of the Specification.

Tobin teaches inductive plasma lighting device in which a sealed gas envelope placed adjacent to a planar inductive coupling structure generates visible light.

Daviet teaches a plasma reactor for processing semiconductor substrates. An induction coil inductively couples power into the reactor to produce a plasma. A thin

electrostatic shield is interposed between the induction coil and plasma to reduce capacitive coupling. Daviet fails to teach or suggest a magnetically transparent electrostatic shield intimately interposed between an induction coil and one side of a lamp body.

On page 4 of the Office Action, the Examiner states that Tobin does not disclose a specified thickness for the electrically conductive layer and notes that "the specification of the thickness for the conductive layer is not shown to solve any problems or yield any unexpected results that are not within the scope of Tobin's shield". Applicant respectfully submits that the Examiner is improperly raising the standard for obviousness. See, in particular, Panduit Corporation v. Dennison Manufacturing Co. at 227 U.S.P.Q. 348 wherein the CAFC stated that "this court has specifically pointed out that, while an "unexpected result", like "synergism", may be evidence of nonobviousness, it is not a requirement". A copy of this decision is enclosed herewith for the Examiner's convenience.

The Examiner further considers the thickness of the shield to be an obvious matter of design choice. Applicant respectfully submits that such a statement is a conclusion made by the Examiner and not a reason for an obvious rejection.

Applicant respectfully submits that under 35 U.S.C. § 103, teachings of references can be combined only if there is some suggestion or incentive to do so. There is no teaching, suggestion, or motivation for modifying the lighting device of Tobin in view of the Daviet's plasma reactor generally used for processing semiconductors as proposed by the Examiner. The only way the Examiner could have arrived at his conclusion is through hindsight analysis by reading into the art the teachings of the Applicant. Hindsight analysis is clearly improper, since the statutory test is whether "the subject matter as a whole would have been obvious at the time the invention was made." Accordingly, the Examiner has clearly failed to establish a prima facie case of obviousness.

Additionally, even if one were to assume, arguendo, that one of ordinary skill in the art would have been led to the combination proposed by the Examiner, one would still not arrive at the instant invention because the resulting combination would not meet all of the limitations recited in independent Claim 1. For example, the resulting combination

would not include a magnetically transparent electrostatic shield including an electrically conductive layer having a thickness between 400 Å and 1000 Å, inclusive, intimately interposed between an induction coil and one side of a lamp body.

Absent such teaching or suggestion, the invention as defined by independent Claims 1 and 5 is deemed fully patentable over the above references. Withdrawal of the rejection under 35 U.S.C. § 103 and allowance of independent Claims 1 and 5 is respectfully urged.

With respect to Claim 2, Applicant respectfully submits that there is no teach or suggestion to incorporate the slits or gaps from the shield of Daviet's plasma reactor into the shield of Tobin's inductive plasma lighting device. In addition, Claim 2 is dependent on independent Claim 1 and thus depends on subject matter deemed patentable for the reasons set forth above. Allowance thereof is also urged.

The remaining cited art has been examined, but is not considered more pertinent to patentability than the art discussed above.

The Application with Claims 1, 2 and 5 is deemed in condition for allowance and such action is respectfully urged. Should the Examiner believe that minor differences exist which, if overcome, would pass the Application to allowance and that said differences can be discussed in a phone conversation, the Examiner is respectfully requested to phone the undersigned at the number provided below.

Respectfully submitted,



Carlo S. Bessone
Reg. No. 30,547

OSRAM SYLVANIA INC.
100 Endicott Street
Danvers, MA 01923
(978) 750-2076